

Customer No.: 31561  
Docket No.: 13321-US-PA  
Application No.: 10/711,472

### REMARKS

In the present Office Action, Specification is objected because the phrase "which are well designed layout", on [p1, Para. 5, line 6], appears to be grammatically incorrect. Claims 10-15 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15-23 are rejected under 35 U.S.C 101 because the claimed invention is directed storing a program implemented by a computer system. Claims 1, 2, 15 and 16 are under 35 rejected U.S.C 102(b) as being anticipated by the article authored by Zarrineh et al., hereinafter Zarrineh, entitled System-on-Chip Testability Using LSSD Scan Structures. Claims 3-9 and 17-23 are objected to as being dependent upon a 102(a) rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims, pending resolution of any additional rejections noted above. Additionally, claims 10-14 are deemed allowable over the prior art at this time, pending resolution of any rejections noted above.

Applicants have amended claims 1, 10-20 and 22-23, and canceled claims 7 and 21. It is believed that no new matter is added by way of these amendments made to the claims.

After carefully considering the remarks set forth in this Office Action and the cited references, Applicant respectfully submitted that the presently pending claims are already in condition for allowance. Reconsideration and withdrawal of the rejection are requested.

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**Discussion of Office Action Objections**

Specification was objected to because the phrase "which are well designed layout", on [p1, Para. 5, line 6], appears to be grammatically incorrect.

In response thereto, Applicants have amended specification.

**Discussion of the Office Action Rejections**

**Claim Rejections – 35 U.S.C. §112**

Claims 10-15 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In response thereto, Applicants have amended claims 10-15 in allowable forms.

**Claim Rejections – 35 U.S.C. §101**

Claims 15-23 are rejected under 35 U.S.C 101 because the claimed invention is directed storing a program implemented by a computer system.

In response thereto, Applicants have amended the subject matter in claims 10-15.

**Claim Rejections – 35 U.S.C. §102**

Claims 1, 2, 15 and 16 are under 35 rejected U.S.C 102(b) as being anticipated by the article authored by Zarrineh et al., hereinafter Zarrineh, entitled System-on-Chip Testability Using LSSD Scan Structures.

In response thereto, Applicant has amended claims 1 and 15, and respectfully traverse the rejections for at least the reasons set forth below.

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As currently amended, claim 1, recites:

*A method of IP characterization, comprising:*  
*providing an IP component;*  
*automatically generating a plurality of test patterns for all paths in the*  
*IP component;*  
*sequentially inputting the test patterns into the IP component for*  
*simulation, and outputting a plurality of corresponding simulation results;*  
*and*  
*extracting at least one key data from each of the simulation results,*  
*respectively; and*  
*integrating the key data of each of the simulation results to generate*  
*the IP characteristic library.*

The factual determination of lack of novelty under 35 U.S.C. 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. V. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Zarrineh fails to disclose that “**extracting at least one key data from each of the simulation results, respectively; and integrating the key data of each of the simulation results to generate the IP characteristic library**”. And, in the present Office Action, Claims 3-9 and 17-23 would be allowable if rewritten in independent form

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including all of the limitation of the base claim and any intervening claims, pending resolution of any additional rejections noted above. Accordingly, amended claims 1 and 15 should be allowable.

Furthermore, claims 2 and 16 should also be patentable since they respectively depend on allowable claims 1 and 15 directly or indirectly.

#### **Claim Objections**

Claims 3-9 and 17-23 are objected to as being dependent upon a 102(a) rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims, pending resolution of any additional rejections noted above.

Claims 3-6 and 8-9, based on their dependency on the allowable claim 1, should be allowable. And, claims 17-20 and 22-23, based on their dependency on the allowable claim 15, should be allowable. Additionally, Applicant has canceled claims 7 and 21.

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**CONCLUSION**

For at least the foregoing reasons, it is believed that the pending claims 1-6, 8-20 and 22-23 are in proper condition for allowance and an action to such effect is earnestly solicited. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,

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